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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,321	03/13/2001	Scott A. Hermreck	580745.004	1791

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EXAMINER

JAKETIC, BRYAN J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,321

Applicant(s)

HERMRECK ET AL.

Examiner

Bryan Jaketic

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 21 is objected to because of the following informalities: "at least data source" in line 3 of the claim should presumably be --at least one data source--.
Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. Claims 6 and 19-24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6 and 19 recite the limitation "IRS form 8283." Such a limitation is indefinite, because IRS forms are subject to change over time.
3. Claim 23 recites the limitation "said export file" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, Claims 1, 2, 7-9, 19, 20, 23-29, 36-39 do not apply, involve use, or advance the technological arts. The claims are directed towards methods that could be performed manually by an accountant or tax advisor. Examiner suggests amending the claims to reflect the use of a computer or electronic memory.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 2, 5-9, 19, 20, 23-29, and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over CASH For Your Used Clothing, 1999 Edition (Hereafter "Cash") in view of Thomas. Cash teaches a method for tracking charitable donations comprising the steps of storing in memory data indicative of donations and a tax deductible valuation for a tax year (see p. 2); prompting a user to select one or more donations and to indicate the year of donation (see p. 8); retrieving tax deductible valuation associated with the selected donation (see p. 8); storing the donation in memory (see p. 9); totaling the tax deductible valuations (see p. 8); presenting the user with informative data, such as notifying the user if an IRS form 8283 is necessary (see p. 12). The donations include non-cash items, monetary donations, financial securities donations, mileage, and out-of pocket expenses (see p. 1).

Cash does not teach the step of storing data a tax deductible valuation associated with a current tax year and previous years. However, Thomas discloses a collection of valuation data for previous years (see p. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the data of Thomas with the invention of Cash, because it is sometimes necessary for taxpayers to file corrected returns for past years.

Cash does not teach the step of exporting the category totals electronically into an income tax return. Cash instead teaches the step of printing a hard copy of the information for manual entry into an income tax return. However, it is obvious to automate a known step, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of electronically exporting category totals into an income tax return, because it is much faster than manually entering the information.

Cash does not teach the step of updating memory with a current set of data. However, it is common in the art to update time-sensitive data. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of updating the memory with a current set of data to ensure that users are properly valuing their donations.

8. Claims 3, 4, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cash and Thomas as applied to claim 1 above, and further in view of Vig. Cash and Thomas disclose all of the limitations as detailed in paragraph 7 of this Office Action. Thomas further teaches the step of calculating a tax-deductible valuation in accordance with tax authority guidelines (see p. 3). Cash and Thomas do not teach the step of receiving sales data from partner servers, wherein the partner servers electronically collect sales data of items sold. Vig teaches the step of receiving sales data through a communications network, wherein partner servers have electronically collected said data (see col. 20, line 53 through col. 21, line 10). It would have been

obvious to one of ordinary skill in the art at the time the invention was made to employ the step of Vig to collect sales data efficiently to make accurate valuations.

9. Claims 10-16 and 30-35 rejected under 35 U.S.C. 103(a) as being unpatentable over Vig. Vig teaches a system for valuating items comprising partner servers having a data source at retail shops where items are sold for electronically capturing sales data of items sold (see col. 20, line 53 through col. 21, line 10); and a system server (100) including a memory for storing sales data, including item description, date of sale, and amount of sale (see col. 5, lines 49-67). The system server is accessible by users (102) via a communications network (104) to provide a search engine that allows users to search the memory to locate sales data corresponding to an item.

Vig does not teach that the valuations of items are used for determining a tax-deductible value of charitable donations. However, it is common in the art to use valuations for tax purposes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the method of Vig to determine a tax-deductible value for a donated item because the method of Vig is efficient and accurate.

Vig does not teach that the data sources are Internet auction web sites. However, items are commonly sold through Internet auction web sites, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ Internet auction web sites as a data sources to receive accurate sales data.

10. Claims 17 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Vig as applied to claims 10-16 above, and further in view of Cash. Vig teaches all of the limitations as detailed in paragraph 9 of this Office Action. Vig does not teach the step

of prompting a user to select donated items. Cash teaches the steps of prompting a user to select one or more donations and to indicate the year of donation (see p. 8); retrieving tax deductible valuation associated with the selected donation (see p. 8); and storing the donation in memory (see p. 9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the steps of Cash with the invention of Vig to aid a user in preparing a tax return.

Neither Cash nor Vig teach the step of exporting the category totals electronically into an income tax return. Cash instead teaches the step of printing a hard copy of the information for manual entry into an income tax return. However, it is obvious to automate a known step, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of electronically exporting category totals into an income tax return, because it is much faster than manually entering the information.

Conclusion

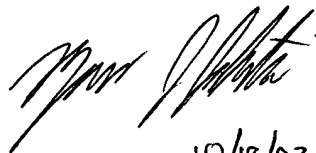
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Malnekoff, Sandholm, Brockman et al, and Dugan disclose systems for valuating items. Miller discloses an electronic tax preparation system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Jaketic whose telephone number is (703) 308-0134. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703)308-5183. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

bj



10/18/03